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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,779	09/15/2000	David R. Corbin	38-21(51376)B	2711

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09/16/2002

Timothy K Ball Phd
Patent Department E2NA
Monsanto Company
800 N Lindbergh Blvd
St. Louis, MO 63167

EXAMINER

SMITH, CAROLYN L

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 09/16/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/663,779

Applicant(s)

CORBIN ET AL.

Examin r

Carolyn L Smith

Art Unit

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period of Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 36 and 37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) (1631)
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Applicant's election of Group III (claims 36-37) in Paper No. 12, filed June 26, 2002, is acknowledged. The applicant's sequence election of SEQ ID NO:1 within the restriction of Group III is also acknowledged.

Applicant's election with traverse of Election/Restriction Requirement in Paper No. 9, filed April 2, 2002, is acknowledged. The traversal is on the ground(s) that the scope of the claims "is not and should not be directed to any specific sequence" because the claims are directed to a computer readable medium which contains the sequences. The traversal to limiting the number of nucleic acid sequences to one and the applicant's request to not be required to elect a single sequence was not found persuasive because, due to the number of these requests made, it is practically impossible to accommodate all requests. The overwhelming number of sequences poses an undue search burden when more than one nucleic acid sequence is elected, thus making the previous waiver for including all sequences on the computer readable medium effectively impossible to reasonably implement.

The requirement is still deemed proper and is therefore made FINAL.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code, such as on page 3, line 5, and elsewhere.

Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

Claims 36 and 37 are rejected under 35 U.S.C. § 112, first paragraph, as lacking sufficient enablement so that one skilled in the art would know how to use the claimed sequence. For probes there is no negative control set forth making it unclear if they are detected by hybridization or by some other means. For a sequence putatively assigned a biological function usage, such as for inhibition, treatment, etc., even if correct, does not appear to be defined as to what use it is to be applied to. The significance of the inhibition of the nucleic acid sequence, such as in transcription, translation, etc. is undefined, further rendering it indiscernible how someone of skill in the art would use such an unknown entity.

Due to the large quantity of experimentation necessary to determine activity or property of the disclosed nucleic acid such that it can be determined how to use the claimed sequence, the lack of direction/guidance presented in the specification regarding the same, the absence of working examples directed to the same, and the breadth of the claims which fail to recite particular biological activities, the specification fails to teach the skilled artisan how to make and use the claimed invention.

Claim 36 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite due to the unclarity of the phrase "or complements thereof." The claims do not

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adequately define the phrase which could mean the complements are 100% similar and of the same length of the claimed sequence or 90% similar and only a fragment of the sequence or any other scenario. Appropriate definition to the degree of complementarity to the claimed sequence is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bret et al.

As the degree of complementarity was not specifically mentioned, Bret et al. disclosed a sequence which is 54.3% similar (in the best matching locality) to SEQ ID NO.: 1. Bret et al., however lack the medium used to store this sequence. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to store any particular information from the computer to a computer readable medium. One of ordinary skill in the art would have been motivated to store sequence information on a computer readable medium just as a patent, such as the one from Bret et al., is already on a computer readable medium as part of the PTO Patenting search system which is publically available.

No claim is allowed.

Conclusion


Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR §1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Smith, whose telephone number is (703) 308-6043. The examiner can normally be reached Monday through Friday from 9 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

September 6, 2002


ARDIN H. MARSCHEL
PRIMARY EXAMINER